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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/972,805	10/05/2001	Vicki L. Chandler	416272061200	6794
20872	7590	01/30/2004	EXAMINER	
MORRISON & FOERSTER LLP 425 MARKET STREET SAN FRANCISCO, CA 94105-2482				MEHTA, ASHWIN D
ART UNIT		PAPER NUMBER		
				1638

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/972,805	CHANDLER ET AL.	
	<b>Examiner</b> Ashwin Mehta	<b>Art Unit</b> 1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 12 November 2003.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 29-34, 41-53 and 61-380 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 29-34, 41-53, and 61-380 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ .                                   |

***Election/Restrictions***

In the restriction requirement mailed September 12, 2003, claims 29-34 were placed in Group XII, and the Examiner indicated that the plants of Group XII were transgenic. In the paper submitted November 12, 2003, which was in response to the restriction requirement mailed September 12, 2003, Applicants stated that claims 29-34 are not directed to a transgenic plant (page 36, 6<sup>th</sup> paragraph). The restriction requirement mailed September 12, 2003 is hereby VACATED, and replaced with the restriction requirement below.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 29-34, 81-100, 121-140, 201-220, and 341-360, drawn to a mutant corn plant comprising one or more mutations wherein said one or more mutations cause an increase in expression of a transgene, classified in class 435, subclass 412.
- II. Claims 41-53, drawn to a process of producing a transgenic corn plant with an activated transgene, classified in class 435, subclass 468, for example.
- III. Claims 161-200, 281-300, and 301-320, drawn to corn seed designated Mop1-1, Mop1-4, Mop1-5, and Mop3-1 plants produced from said seed, progeny seed produced from said plants, tissue cultures of regenerable cells of said plants, a process of producing corn seed, comprising crossing said plant, hybrid corn seed produced from said process, classified in class 800, subclass 320.1, for example.
- IV. Claims 101-120, 141-160, 241-260, and 321-340, drawn to corn seed designated rmr7-1, rmr7-2, rmr11-1, and CC2343, plants produced from said seed, progeny

seed produced from said plants, tissue cultures of regenerable cells of said plants, a process of producing corn seed, comprising crossing said plant, hybrid corn seed produced from said process, classified in class 435, subclass 424, for example.

V. Claims 61-80, 221-240, 261-280, and 361-380, drawn to corn seed designated rmr1-2, rmr6-1, rmr8-1, and rmr9-1 plants produced from said seed, progeny seed produced from said plants, tissue cultures of regenerable cells of said plants, a process of producing corn seed, comprising crossing said plant, hybrid corn seed produced from said process, classified in class 800, subclass 275, for example.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, III, IV, V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation and structures, and the plants of the different groups are genetically distinct. The mutations of the plants of Group I cause an increase in expression of a transgene. An increase in transgene expression is not required by the plants of Groups III, IV, and V. Further, the plants of each of Groups I, III, IV, and V have different mutations, giving them different structures. That the plants of each of the groups are distinct from each other is also evidenced by their separate deposits with the ATCC. Different searches would be required for the different plants.

Inventions I, III, IV, V and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for

using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, as the plants of Groups I, III, IV, and V can be used in a process comprising crossing with other non-transgenic corn plants, to produce novel corn varieties.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for each of Groups II-V, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Contact Information***

Any inquiry concerning this or earlier communications from the examiner should be directed to Ashwin Mehta, whose telephone number is 571-272-0803. The examiner can normally be reached on Mondays-Thursdays and alternate Fridays from 8:00 A.M to 5:30 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy

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Nelson, can be reached at 571-272-0804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 and 703-872-9306 for regular communications and 703-872-9307 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

January 23, 2004



Ashwin D. Mehta, Ph.D.  
Primary Examiner  
Art Unit 1638